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BUCHANAN, INGERSOLL & ROONEY PC
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EXAMINER	
CHANG, VICTOR S	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENT MALMGREN, SHABIRA ABBAS,
BENGT WIDBERG, ASA OSTMAN, and
JEANETTE ANNERGREN

Appeal 2008-2394
Application 09/651,130
Technology Center 1700

Decided: November 25, 2008

Before EDWARD C. KIMLIN, CATHERINE Q. TIMM, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants, pursuant to 37 C.F.R. § 41.52, have submitted a timely Request for Rehearing dated August 27, 2008 (hereafter the "Request"), requesting rehearing of the original Decision in this appeal dated June 30, 2008 (hereafter "Dec.").

The Examiner rejected claims 1, 2, 4-13, 15, and 20 (directed to a foam material) under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Chen.

We affirmed the Examiner's rejection of claims 1, 2, 4-13, 15, and 20 under 35 U.S.C. § 103(a) as unpatentable over Chen, and reversed the rejection under 35 U.S.C. § 102(e) (Dec. 9).

ISSUE

Have Appellants established that the Board has erred in affirming the § 103 rejection by not properly considering that: 1) there are several competing result effective variables for the structure of a foam material, and 2) the recited combination of results has not been recognized as a desirable combination (Request 1)?

ANALYSIS

Appellants have **not** challenged or rebutted the findings of fact in this record that the properties listed in claim 1 are result effective variables (Request 1-5; see also Dec. 5-7). Rather, they argue that "certain of the production factors [of the process for producing the foam] may increase one of the claimed properties, while decreasing others" (Request 2).

One of ordinary skill in the art would have recognized that the value of each result effective variable is a factor in achieving any particular balance of properties in a foam material. That is, one of ordinary skill in the art would have readily appreciated that properties of products often compete with one

another, and, as one parameter changes for the better, another may deteriorate[1]. As we stated in our Decision:

> [W]e determine that any picking and choosing of the appropriate process steps as taught in Chen necessary in order to optimize the absorbent product described therein and its properties would have been prima facie obvious in view of the similarity between the product and process claimed here and the product and process described in Chen (as pointed out by the Examiner, Ans. 3-6).

(Dec. 8).

It is axiomatic that once it is established that the properties are result effective variables, as here, the burden shifts to the Appellants to provide evidence that the values for the claimed properties produce a result that is unexpectedly good. *See Pfizer, Inc. v. Apotex*, 480 F.3d 1348, 1368 (Fed. Cir. 2007). It is axiomatic that the burden of demonstrating unexpected results that are commensurate in scope with the claimed subject matter rests on the party asserting them. *In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972); *see also In re Merck & Co*., 800 F.2d 1091, 1099 (Fed. Cir. 1986).

As explained in our decision, Appellants simply have not provided any such evidence (Dec. 7-9).

Appellants state they have "unexpectedly discovered a foam that has optimized both absorption rate and liquid storage capacity" (Request 3). However, these comments are mere attorney argument and cannot take the

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[1] During oral hearing, Appellants' representative admitted that one of ordinary skill in the art would have realized "this tradeoff in properties" for the parameters at issue was known (Oral Hearing Transcript 11:12-15; "I can't say for sure but I would suspect yes, that that was known.").

place of evidence. *In re Greenfield*, 571 F.2d 1185, 1189 (CCPA 1978). *See also In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) ("[I]t is well settled that unexpected results must be established by factual evidence. 'Mere argument or conclusory statements in the specification does not suffice."').

CONCLUSION

For the foregoing reasons, Appellants have not persuaded us that our decision was in error in any respect. We have considered Appellants' Request for Rehearing but find no points misapprehended or overlooked in our original Decision. Therefore, Appellants' Request for Rehearing is DENIED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

PL INITIAL:
sld

BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404